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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|--|-------------|----------------------|----------------------|------------------|
| 10/773,405   | 02/09/2004  | Hiroshi Yoshigi      | ASAM.0110            | 6609             |
| 7590   | 01/04/2007  |                      | EXAMINER             |                  |
| Stanley P. Fisher<br>Reed Smith LLP<br>Suite 1400<br>3110 Fairview Park Drive<br>Falls Church, VA 22042-4503 |             |                      | BANGACHON, WILLIAM L |                  |
|  |             |                      | ART UNIT             | PAPER NUMBER     |
|  |             |                      | 2612                 |                  |
| SHORTENED STATUTORY PERIOD OF RESPONSE   |             | MAIL DATE            | DELIVERY MODE        |                  |
| 3 MONTHS   |             | 01/04/2007           | PAPER                |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                  |                     |
|------------------------------|----------------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b>           | <b>Applicant(s)</b> |
|                              | 10/773,405                       | YOSHIGI ET AL.      |
|                              | Examiner<br>William L. Bangachon | Art Unit<br>2612    |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 October 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 5,6 and 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 5,6 and 10-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892) ✓
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: Examiner's comments.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments filed 10/16/2006 with respect to claims 5-6 and 10-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 5-6 and 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,608,417 (hereinafter 'de Vall') in view of USP 6,522,308 (hereinafter 'Mathieu'), and further in view of Teach Yourself Electricity and Electronics, 2nd Edition, by Stan Gibilisco.

In claim 5, de Vall teaches of a contactless identification (transponder) comprising:

an antenna copper coil (L') {Figure 1, 4 or 6} formed on the opposite surfaces of a Fleximide substrate (i.e. base) in generally rectangular spirals (i.e. metallic vortex pattern) {col. 3, lines 31-33+, lines 45-50+};

a first capacitor (C'); and

an IC chip (20), wherein one terminal of the IC chip is connected to the antenna coil (L') through the first capacitor, wherein the antenna coil, the first capacitor and the IC chip are connected in series as shown in Figure 3b. The capacitor C' and coil L' forms a series resonant circuit wherein the voltage is maximized at the resonant frequency of this circuit {see de Vall, col. 4, lines 31-35+}.

de Vall does not disclose "**the first capacitor has a capacitance smaller than an input capacitance of the IC chip**". Mathieu, in the same field of endeavor, teaches that the input capacitance introduced by an IC chip in the manufacture of tags/transponders is inherent {Mathieu, col. 1, lines 32-37+}. de Vall shows in Figs. 3a and 3b that resonating circuits can be either series or parallel. Mathieu describes that as the input capacitance of the chip (CS1 in Fig. 5) gets smaller and smaller, a capacitance value CS2 obtained with the screen-printed capacitor 52 is added to compensate (so the overall capacitance stays the same) {Mathieu, col. 4, lines 22-33+}. The particular design used by Mathieu is a parallel resonating circuit. With parallel circuits, the total capacitance is CS1 + CS2 {See Teach Yourself Electricity and Electronics, 2nd Edition, by Stan Gibilisco, page 203}. As CS1 gets smaller, CS2 has to get larger to compensate. In a series circuit, the relationship between the two capacitors is  $1/CS2 + 1/CS1$  {See Teach Yourself Electricity and Electronics, 2nd

Edition, by Stan Gibilisco, page 202}. As CS1 gets smaller, CS2 must also get smaller to compensate. Therefore, the series relationship is inverse to the parallel relationship. As Mathieu discloses a large capacitor is needed to compensate for the chip capacitor getting smaller {Mathieu, col. 4, lines 31-33+} and de Vall discloses that either a parallel or series resonator can be used, it would have been obvious to one of ordinary skill in the art, at the time of applicant's invention, to use a series resonator in place of the parallel resonator disclosed by Mathieu. Once this replacement is done, it is inherent that first capacitor C' be smaller than the input capacitance of the IC chip to achieve the same effect. See also Stan Gibilisco, pages 318-319.

In claim 6, a second capacitor C connected in parallel with said IC chip 20, wherein said first capacitance has a capacitance smaller than the sum of the input capacitance of said IC chip and a capacitance of said second capacitor since the first capacitance is smaller than the input capacitance of the IC chip and that the second capacitance, being connected in parallel with said IC chip, has to be greater than the input capacitance of said IC chip. Also see Mathieu, col. 4, lines 31-33.

In claim 10, de Vall teach of a base as shown in Figure 1, wherein said antenna coil (4 or 6) comprises a metallic pattern (i.e. copper layer) formed on said base (i.e. substrate), and any of said capacitors comprises metallic patterns formed on both sides of said base {col. 3, lines 26+}.

In claim 11, said contactless identification comprises an IC card {see de Vall, col. 1, lines 11+}.

In claim 12, said contactless identification comprises a portable terminal {see de Vall, col. 7, lines 26-35}. i.e. credit cards are portable.

In 13, de Vall teaches that the first capacitor capacitance and an inductance of the antenna coil dominantly determine a resonant frequency of a series circuit including the IC chip, the antenna coil, and the first capacitor as shown in figure 3b.

In claim 14, the first capacitor is formed by a metallic pattern (4 and 6) on both sides of the base {see de Vall, Figure 1}.

In claim 15, the base is made of a polyimide material (i.e. fleximide substrate) {see de Vall, col. 3, lines 46-49}

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

EP 0312792 A1 (Baro, Jose) is cited in that it teaches of a circuit recited in claims 5 to 6 {see Figures 4 and 5}.

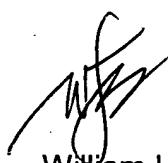
### ***Office Contact Information***

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to William Bangachon whose telephone number is (571)-272-3065. The Examiner can normally be reached on Monday – Thursday, 8:30 AM – 4:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wendy Garber can be reached on **(571)-272-7308**. The fax phone numbers for the organization where this application or proceeding is assigned is **571-273-8300** for regular and After Final formal communications. The Examiner's fax number is **(571)-273-3065** for informal communications.

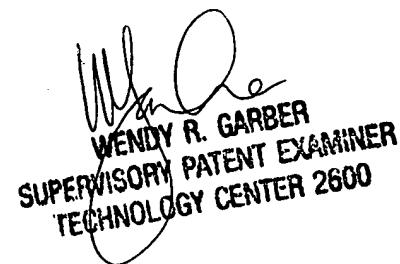
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



William L Bangachon  
Examiner  
Art Unit 2635

November 10, 2006



WENDY R. GARBER  
SUPERVISORY PATENT EXAMINER  
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